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In re Application
Presta et al.
Application No. 10/027,736
Filed: December 19, 2001
Atty Docket No. 11669.92US01

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: DECISION ON APPLICATION
: FOR PATENT TERM ADJUSTMENT
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This is a decision on the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 C.F.R. §1.705(b)," filed June 15, 2004. Applicants request that the initial determination of patent term adjustment under 35 U.S.C. 154(b) be corrected from one hundred fifty-three (153) days to one hundred fifty-seven (157) days.

The application for patent term adjustment is **DISMISSED**.

On March 15, 2004, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above identified application. The Notice stated that the patent term adjustment (PTA) to date is one hundred fifty-three (153) days. On June 15, 2004, Applicants timely¹ submitted an application for patent term adjustment, asserting that the correct number of days of PTA at the time of the mailing of the Notice of Allowance is one hundred fifty-seven (157) days.

Applicants specifically state that the patent issuing from the application is not subject to a terminal disclaimer.

¹ Applicants filed the instant application for patent term adjustment together with the payment of the issue fee.

The Office initially determined a patent term adjustment of one hundred fifty-three (153) days based on an adjustment for PTO delay of three hundred thirteen (313) days pursuant to 35 U.S.C. 154(b)(1)(A)(i) and 37 C.F.R. § 1.703(a)(1), reduced by applicants' delay of one hundred twenty (120) days pursuant to 35 U.S.C. 154(b)(2)(C)(i) and 37 C.F.R. § 1.704(c)(7) and forty days pursuant to 35 U.S.C. 154(b)(2)(C)(i) and 37 C.F.R. § 1.704(c)(8). The PTO delay of 313 days and applicants' delay of 40 days have been reviewed and found to be correct. The adjustment of one hundred twenty (120) days is at issue.

With respect to the one hundred twenty (120) days of applicant delay, Applicants assert that they filed a response pursuant to 37 C.F.R. 1.704(c)(7) on August 19, 2002, and therefore should have only been assessed delay of one hundred sixteen (116) days.

The Office mailed a Notice to File Missing parts of February 27, 2002, requiring an oath or declaration and a sequence listing. Applicants filed a response to the Notice on April 25, 2002. However, on June 17, 2002, the Office mailed a Notice to Comply, requiring a new sequence listing. Applicants filed a proper sequence listing on August 23, 2002. Applicants' response contained a Certificate of Mailing dated August 19, 2002.

However, under 37 C.F.R. § 1.703(f), "the date indicated on any certificate of mailing or transmission shall not be taken into account" in the PTA calculation. See also Changes to Implement Patent Term Adjustment under Twenty-Year Patent Term; Final Rule, 1239 OG 14 (Oct. 3 2000). Accordingly, the applicant delay of one hundred twenty (120) days for the filing of the sequence listing on August 23, 2002 was proper.

The correct determination of patent term adjustment at the time of the mailing of the Notice of Allowance is **one hundred fifty-three (153) days** (313 days of PTO delay, reduced by 160 (120+40) days of applicant delay).

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e).

The application file is being forwarded to the Office of Patent Publication to complete the issuance process for the patent.

Telephone inquiries specific to this matter should be directed to Cliff Congo, Petitions Attorney, at (571)272-3207.



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